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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 522

SENCO PRODUCTS, INC.,

Petitioner,

vs.

FASTENER CORPORATION AND DUO-FAST CO.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Senco Products, Inc., prays that a writ of certiorari issue to review the decision and decree of the United States Court of Appeals for the Seventh Circuit which affirmed the decision of the District Court for the Northern District of Illinois, Eastern Division, in the matter of *Senco Products, Inc. v. Fastener Corporation and Duo-Fast Co.*

OPINIONS BELOW.

The opinion of the Court of Appeals for the Seventh Circuit is reported at 269 F. 2d 33.[1]

The opinion of the District Court for the Northern District of Illinois, Eastern Division, is reported at 168 F. Supp. 850 (A. p. 671).[2]

As will be developed further, the same patent here involved was litigated in the sixth circuit. The opinion of the District Court in the sixth circuit is unreported but appears in the record (A. p. 501) and the affirming opinion of the Court of Appeals for the Sixth Circuit is reported at 242 F. 2d 565.[3]

STATEMENT OF JURISDICTION.

The Court of Appeals for the Seventh Circuit delivered its opinion and rendered judgment thereon on July 8, 1959.

A petition for rehearing was denied without further opinion on August 13, 1959.

Jurisdiction is believed conferred on this Court to review the judgment in question by writ of certiorari by the Act of June 25, 1948, 28 U. S. C. 1254, and Rule 19, section 1(b) of this Court because "* * * a court of appeals (the Seventh) has rendered a decision in conflict with the decision of another court of appeals (the Sixth) on the same matter (the validity of patent 2,671,214):". The Petition is timely under 28 U. S. C. 2103(c).

1. Appendix A; further reference to this will be (App. A. p. ....).

2. A. refers to the Joint Appendix used before the Court of Appeals for the Seventh Circuit; this constitutes the record here.

3. Appendix B; further reference to this will be (App. B. p. ....).

THE QUESTIONS PRESENTED FOR REVIEW.

The judgment of the Court of Appeals for the Seventh Circuit, affirming the District Court's holding that United States Letters Patent No. 2,671,214 is invalid, is directly in conflict with the judgment of the Court of Appeals for the Sixth Circuit, affirming the District Court's holding that United States Letters Patent No. 2,671,214 is valid. The specific questions presented, therefore, are:

1. When a District Court uses an incorrect standard of invention and finds a patent invalid, may a Court of Appeals affirm this finding without commenting on such incorrect standard of invention; particularly when this standard has specifically been abrogated *by statute?*

2. When the patent statutes state that a patent is presumed valid, may a Court of Appeals arbitrarily hold that this presumption of validity does not exist as against prior art not "before" the Patent Office, *when the statute makes no such exception* and when it is just as reasonable to conclude that the art not specifically mentioned by the Patent Office was considered by it and cast aside as not pertinent?

3. May a Court of Appeals refuse to consider substantial commercial success as evidence of validity when the patent in suit did not issue until after a hotly contested inter-party contest on the question of patentability was conducted by the Patent Office and another Court of Appeals had found the patent valid?

4. May a Court of Appeals make mis-statements about the teaching and operation of prior art patents and devices and then rely on such mis-statements in holding a patent invalid as lacking invention over such prior art?

THE STATUTES INVOLVED.

The Patent Act of July 19, 1952 (Public Law 593, 82d Cong., 2d sess., ch. 950; 66 Stat. 792), effective January 1, 1953, provides at Title 35, United States Code, section 282 as follows:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

This same Patent Act also provides at Title 35, United States Code, section 103 as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE.

This is an action for injunction and accounting based on infringement of United States Letters Patent No. 2,671,214, dated March 9, 1954, for Staple Drive Mechanism for Portable Pneumatic Staplers (A. p. 687). Federal jurisdiction in the court of first instance, therefore, was based on the Patent Statutes, 35 U. S. C. sections 271, 281, 283, 284 and 285.

Infringement of the patent is admitted (A. p. 7). Novelty of the invention over the prior art has been established in that both the District Court (A. p. 677) and the Court of Appeals (App. A, p. 19) found the invention to be an "improvement". The primary issue, therefore, is the *patentability* of the invention.

The Invention.

The invention has become widely known in the industry as the "free running driver" invention. It resides in a portable pneumatic stapler which may be grasped much like a large revolver and employed to "fire" a staple into work. A piston, slidable in a cylinder under the influence of air pressure as controlled by pulling a trigger, causes a driver to engage a staple and push it into work whereby to staple same.

In this novel stapler the piston and driver are separate, not rigidly connected together, and there is a definite, separate stop for the piston. The arrangement is such that when the tool is fired the driver and piston accelerate together and move as a unit in the staple driving direction until the piston is stopped by its separate stop, whereafter the driver is free to continue its movement in the staple driving direction, due to its accumulated kinetic energy, to complete the setting of the staple. The driver is stopped by using up its accumulated kinetic energy in setting the staple, or by a stop in the form of a spring, or both. (The spring serves both to return the piston and driver after the gun is fired and as a final limit stop for the stroke of the driver.) In this manner a variable distance of stroke for the driver is provided so that complete setting of the staple is accomplished even though the gun may be brought to the work in a variety of positions. And the actual force applied in setting the staple may be reduced during the driving of the staple by this stopping of the piston separately from the driver.

The reasons why Plaintiff's staplers have been successful in the practical art may be summarized in this way: If the driver were rigidly attached to the piston the on fire driving stroke would be a full power driving stroke. If the driver failed to reach the end of the slide through which

the staple is driven, the staple could not fully be driven home. If the driver extended beyond the end of the slide at the conclusion of the driving stroke the upholstery material which is being stapled would be torn or gouged. Further, it has been shown that a rigid connection between the piston and the driver makes for excessive driver breakage. But where the driver is divorced from the piston, and where separate stops are provided both for the piston and the driver, so located that after the piston has been arrested the driver can move forwardly under its own momentum, the full power of the driving stroke ceases when the piston is arrested, and the driver is able to continue its motion under the lesser force of its own inertia so that it can drive the staple home without tearing or gouging the upholstery fabric.

As a result of the invention staples are now being widely used in industry. These stapling tools are available to the industry from Petitioner, Senco Products, Inc., from Respondents, Fastener Corporation and Duo-Fast Co., and from Bostitch, Inc. Those made by Senco and Bostitch are made under authority of the patent. The respondents admittedly use the patented free running driver feature in their staples but seek to avoid recognizing the patent in suit.

The Prior Art.

The Court of Appeals relied on five items of prior art in holding the patent invalid. As to each the Court made the following statements:

Bradeen patent No. 451,995 (*A. pp. 722-728*)

"The Bradeen tacking machine patent incorporates the basic essentials of stapling machine devices. The driver and piston form one piece and there is but one stop for the piston and driver." (App. A. p. 19.)

Randall patent No. 1,939,632 (A. pp. 832-841)

"This device utilized a piston separate from the driver, although the latter was rigidly secured to a floating auxiliary plunger. There were, however, no separate stops for the piston and driver." (App. A. pp. 18-19.)

Randall "Commercial" gun (Shown in Defendants' Exhibit 226)

"In a Randall commercial gun introduced in evidence by Defendants and represented by drawings in defendants' exhibit 226 there was a loose connection between the piston and driver which allowed the driver a slight degree of movement after the piston had stopped." (App. A. p. 19.)

Von Vass patent No. 1,186,458 (A. pp. 801-805)

"The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver." (App. A. p. 19.)

Carmina patent No. 1,142,671 (A. pp. 792-800)

"The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops for the piston and driver." (App. A. p. 19.)

ARGUMENT.

CONFLICT OF DECISIONS.

Staplers embodying the invention are widely used in many industries throughout the United States.

It is well settled that the Supreme Court should resolve conflicting views of two Courts of Appeals as to a single patent:

Expanded Metal Co. v. *Bradford*, 214 U. S. 366, 374.

Diamond Rubber Co. v. *Consolidated Tire Co.*, 220 U. S. 428, 430.

Sanitary Refrigerator Co. v. *Winters*, 280 U. S. 30, 34.

Triplett v. *Lowell*, 297 U. S. 638, 644.

Universal Oil Prod. Co. v. *Globe Oil & Ref. Co.*, 322 U. S. 471, 473.

In the case last cited the Supreme Court stated:

> "But in resolving conflicting views of two Circuit Courts of Appeals as to a single patent, we are obliged to undertake an independent re-examination of the factual questions."

The District Court in the sixth circuit found the patent in suit valid (A. p. 501). At oral argument before the Court of Appeals for the Sixth Circuit, counsel for the party opposed to the patent conceded validity, whereafter the Court of Appeals affirmed, *Sasser, et al.* v. *Seneca*, 242 F. 2d 565 (App. B. p. 23).

When a district court finds a patent valid, and patent validity is thereafter admitted upon appeal to the Court of Appeals, which Court of Appeals affirms, the validity

of the patent in that circuit is finally determined, *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 33.

In the case at bar the District Court in the seventh circuit found the patent in suit invalid (A. p. 671). The Court of Appeals for the Seventh Circuit affirmed, *Senco v. Fastener et al.*, 269 F. 2d 33 (App. A. p. 20).

This conflict must be resolved. The industry is completely up in the air as to whether the patent is valid or invalid.

STANDARD OF INVENTION.

The Patent Act of July 19, 1952, effective January 1, 1953, provides in part as follows (35 U. S. C. 103):

> "Patentability shall not be negatived by the manner in which the invention was made."

It does not appear that this Court has yet had occasion to apply this section of the new Patent Law. The "Reviser's Note" states that:

> "The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius."

The District Court in the seventh circuit held the patent in suit invalid because:

> "No where in the operation can I find the flash of creative genius which is necessary to constitute invention. *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84." (A. pp. 677, 678.)

Thus the District Court applied a standard of invention which Congress had specifically abrogated after some eleven years! The Court of Appeals for the Seventh Circuit affirmed this decision without comment on the standard of invention employed by the District Court. This confusion should be resolved.

PRESUMPTION OF VALIDITY—CASES AND STATUTE.

The Patent Act of July 19, 1952, effective January 1, 1953 provides as follows (35 U. S. C. 282):

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

The *only* mention made by the Court of Appeals as to the presumption of validity is as follows (App. A. p. 20):

> "The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office."

The statute (35 U. S. C. 282) makes no such exception!

Such holding is even in conflict with other decisions of the Court of Appeals for the Seventh Circuit which hold that the mere fact that a patent was not *cited* by the Patent Office does not mean that such patent was not "before" the Patent Office; it may have been considered and cast aside as not pertinent. *Adler Sign Letter Co.* v. *Wagner Sign Service*, 7 Cir., 112 F. 2d 264, 267.

Furthermore, the patent in suit did not issue until after the Patent Office had conducted a hotly contested three party interference in which patentability was the primary issue; the Patent Office found the claims patentable (A. pp. 511, 516). This Court has held that under similar circumstances this presumption of validity "must have greatly increased weight", *Hildreth* v. *Mastoras*, 257 U. S. 27, 32.

It is submitted, therefore, that the Court of Appeals for the Seventh Circuit did not properly apply the *statutory* presumption of validity to the patent at bar and that, if it had, it surely would have found the patent valid, especially in view of the fact that both the District Court and the Court of Appeals found the patent was for an improvement (A. p. 677 and App. A. p. 19)!

COMMERCIAL SUCCESS.

The stapler of the patent in suit met with surprising commercial success (A. p. 121). The Respondents praise the prior art but they follow the patent in suit, not the prior art, and they admit infringement (A. p. 7).

Long ago this Court recognized that commercial success, in a close case, could "turn the scale in favor of the invention", *Potts* v. *Creager*, 155 U. S. 597, 609, and "tip the scales in favor of patentability", *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279.

Finally, it has been observed that the Respondents praise the prior art but practice the invention. This is itself believed indicative of invention and has been so held by this Court, *Diamond Rubber Co.* v. *Consol. Tire Co.*, 220 U. S. 428, 441. Yet the Court of Appeals for the Seventh Circuit refused to consider commercial success on the ground it was irrelevant (App. A. p. 20).

This Court is respectfully urged by Petitioner to consider the factors which should tip the scales in favor of the patentability of the invention at bar.

MIS-STATEMENTS BY THE COURT OF APPEALS.

The Court of Appeals for the Seventh Circuit recognized that the patent at bar is for an "improvement and development" (App. A. p. 19). Since no court is warranted in deciding, *in vacuo*, whether an improvement is a *patentable* one, it appears that the Court of Appeals must have felt that the improvement was not patentable because the inventor simply borrowed certain features from the prior art and added them to existing structures.

The discussion of the prior art by the Court of Appeals (which essentially follows the analysis of the District Court) does not substantiate either that plaintiff

made his admitted "improvement and development" by borrowing from the prior art, or that plaintiff secured no "unusual or surprising consequences" from what he did.

In the preceding Statement of the Case *all* that the Court of Appeals had to say about the prior art it relied on is set forth verbatim. As to the Bradeen and Randall patents the Court of Appeals was substantially correct. As to the remaining three items of prior art it was not. **The incorrect interpretation of these three items is crucial.**

The Court referred to the Bradeen patent as showing an early effort at driving staples with an air operated tool. This patent, however, shows nothing more than an air operated driver with an air return: the driver is rigidly fixed to a piston and there are no separate stops for the driver and piston. The Randall patent shows a driver with a piston attached and a supplementary piston above it; but fails to show or suggest separate stop means for the driver assembly and for the supplementary piston. The Randall "commercial" gun simply shows the combination of a piston and a driver wherein the connection between the driver and the piston is characterized by a few thousandths of an inch of play, which could serve no purpose beyond that of facilitating the connection of the driver and piston during assembly of the structure. Indeed, there are no mechanical stops at all in this gun. *Thus, in the Randall commercial gun, the Randall patent and the Bradeen patent, there are no separate stops for the piston and the driver.*

This leaves only the Von Vass patent and the Carmina patent in the Court's opinion as sources from which plaintiff could have borrowed those features which constitute the improvement and development over the broad idea of an air actuated driver for staples as shown in Bradeen. *Neither patent is capable of serving as such a source.*

Von Vass (Appendix, p. 802) shows a hand operated, non-pneumatic device having a tubular body. A driver with a head extends through the lower end of the tubular body. A rod having a head extends through the upper end of the tubular body and is fitted with a handle. The driver is returned to an inactive position by a spring. In the use of the device, the rod is drawn upwardly by the operator (a plug 21 in the upper end of the tubular body coacts with the head 24 on the rod to prevent its complete withdrawal and this is the *only* function attributed to the member 21 by the patentee, A. p. 804, ll. 61-63) whereupon the rod is manually brought forcibly downwardly in the tubular body until its head 24 strikes the head 25 on the driver. The driver is, of course, moved forcibly downwardly as by a hammer blow; but the heads 24 and 25 remain together throughout the entire extent of the driver travel. While the driver may be stopped by the spring, the head on the rod cannot previously be stopped. A measurement of the figures of the Von Vass patent indicates that the two heads remain in contact throughout the entire extent of driver travel.

The Carmina patent (A. p. 792) is on a pneumatic percussion tool. It has a piston and it has also a chisel-receiving socket provided with a laterally extending spring pin. The chisel is provided either with an annularly reduced portion or with an elongated groove in which the pin may engage (Appendix, p. 796, Figs. 13 and 14). This is merely for the purpose of retaining the chisel in the socket. The structure of Carmina is employed by bringing the chisel against the work; and the chisel is caused to exert a blow on the work because it is hit by the air driven piston. But in the use of a structure of this kind where the cutting end of the chisel must be held against the work to be effective, the blow exerted on the chisel by the plunger can cause a movement of the chisel only to the extent that

the work is cut by the chisel. In the Carmina structure, the pin which has been described is not a separate stop for the chisel and could not act as such. If the device were held so that the chisel could move longitudinally, it is evident that the pin would be sheared off so that it could no longer even retain the chisel, let alone act as any kind of stop.

Plaintiff's concept which contemplates a piston, a driver which is free of the piston and separate means to stop both the driver and the piston, so that the driver is free to advance by inertia after the piston is stopped, is clearly not to be found in any prior art to which the Court has referred nor in any combination thereof. There simply was nothing in the prior art from which Plaintiff could have borrowed to arrive at the structure of the patent in suit.

It is submitted that the Court of Appeals was clearly in error in its analysis and application of the prior art. Correctly analyzed and applied, patentable invention would be clear! As herein previously noted, in cases wherein there is a conflict of decisions among the Courts of Appeal, and error has been made, it is the duty of the Supreme Court to re-examine and to resolve the conflict, *Universal Oil Prod. Co. v. Globe Oil & Ref. Co.*, 322 U. S. 471, 473 wherein it was stated:

> "But in resolving conflicting views of two Circuit Courts of Appeals as to a single patent, we are obliged to undertake an independent re-examination of the factual questions."

CONCLUSION.

Issuance of the writ of certiorari is respectfully prayed, for all of the above reasons, that upon review of this case the conflict of decisions between the Courts of Appeals for the Sixth and Seventh Circuits as to the validity of the patent at bar will be resolved; the correct standard of invention will be applied; the statutory presumption of validity will be followed; the mis-statements of the Court of Appeals for the Seventh Circuit will be corrected; and patent 2,671,214, admittedly infringed, will be held valid.

Respectfully submitted,

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APPENDIX A.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit.

September Term, 1958—April Session, 1959.

No. 12548
SENCO PRODUCTS, INC.,
Plaintiff-Appellant,
v.
FASTENER CORPORATION and DUO-FAST CO.,
Defendants-Appellees.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

July 8, 1959.

Before SCHNACKENBERG, KNOCH and CASTLE, *Circuit Judges.*

CASTLE, *Circuit Judge.* Senco Products, Inc., plaintiff-appellant, a manufacturer of staples and staplers, (hereinafter called plaintiff) brought suit in the District Court against Fastener Corporation, a manufacturer of similar devices and Duo-Fast Co., its Illinois distributor, defendants-appellees, (referred to as defendants) for an injunction for damages for alleged patent infringement. The District Court entered judgment finding the patent invalid for lack of invention and dismissed the complaint. Plaintiff appealed. The main contested issue is whether the District Court erred in holding the patent invalid for lack of invention in view of certain prior art.

The stapling devices or "guns" manufactured by both parties are of a portable pneumatic type designed primarily for use in upholstering operations. The staple driving mechanism of the patent in suit features a separate driver and piston with a separate stop for the piston, so arranged that the driver and piston accelerate together and move as a unit in the staple driving operation until the piston is stopped. The driver, due to its accumulated kinetic energy, continues its movement to complete the setting of the staples without further force or energy from the piston. The driver advances slightly beyond the tip of the gun. A spring serves as a final limit stop for the driver. Advantages claimed for this mechanical arrangement are the elimination of frequent driver breakage encountered when the driver and piston are in one unit or when rigidly connected and proper staple setting without injury to the material stapled. Plaintiff contends that the two features—the separate driver and piston and the separate piston stop served to distinguish its patent from all prior art.

The defendants rely on references to prior art which they contend disclose the use of separate pistons and drivers and separate stops for each in similar tools. The references included devices for stapling, tacking, nailing, riveting and other percussion tools. It would unduly lengthen this opinion to discuss each reference in detail. We have considered each reference and the arguments of counsel bearing on its relevance.

Pneumatic stapling guns were actually designed as early as 1891 (Bradeen patent 451,995). Evidence of prior art considered by the District Court and upon which it based its conclusion included the Randall patent 1,939,632 covering a portable pneumatic stapling machine. This device utilized a piston separate from the driver, although the

latter was rigidly secured to a floating auxiliary plunger. There were, however, no separate stops for the piston and driver. In a Randall commercial gun introduced in evidence by defendants and represented by drawings of defendant's exhibit 226 there was a loose connection between the piston and driver which allowed the driver a slight degree of movement after the piston had stopped. The Bradeen tacking machine patent incorporates the basic essentials of stapling machine devices. The driver and piston form one piece and there is but one stop for the piston and driver. Other percussion tools, however, were shown to have incorporated separate pistons and drivers. The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver. The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops for the piston and driver. The foregoing examples of prior art and evidence concerning tools in commercial use in our view sustain the District Court's conclusion that although the plaintiff's stapling device represented improvement and development, such improvement and development was the result of mechanical skill only. The arrangement of the features incorporated by the plaintiff in its device did not possess the "impalpable something which distinguishes invention from simple mechanical skill." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147. These features had been employed in other similar types of tools. Their adaptation by plaintiff resulted in an improvement but represents no more ingenuity than the work of a mechanic skilled in the art. There are no "unusual or surprising consequences from the unification of the elements here concerned" nor did plaintiff's utilization

of the features it mentions "add to the sum of useful knowledge". *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147.

It is enough to defeat a patent under 35 U.S.C.A. § 103 that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious. *Enterprise Ry. Equip. Co. v. Keystone Ry. Equip. Co.*, No. 12508, C.C.A. 7th Cir., opinion filed May 20, 1959.

The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office. *Hobbs v. Wisconsin Power & Light Company*, 250 F. 2d 100, 105. Of the aforesaid prior art relied upon by the defendants only Randall and Pardee patent 2,304,650 were before the Patent Office.

We hold the patent invalid for lack of invention. Consideration of commercial success is therefore irrelevant. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147.

The judgment of the District Court is

AFFIRMED.

APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS.
For the Sixth Circuit.

No. 12901
TRAVIS M. SASSER (doing business as Cincinnati Shippers Supply Co. and Dayton Fastener—both individual proprietorships owned by Travis M. Sasser) and Shipping Room Supplies, Inc.,
Defendants-Appellants,
v.
SENCO PRODUCTS, INC.,
Plaintiff-Appellee.

Appeal from the United States District Court for the Southern District of Ohio, Western Division.

Decided March 26, 1957

Before SIMONS, *Chief Judge*, and MCALLISTER and MILLER, *Circuit Judges*.

Per Curiam.

Senco Products, Inc., appellee, sued appellants for direct infringement of its patents for staplers; for contributory infringement; for inducing infringement thereof; and for unfair competition. Appellants defended on the ground that the patents in issue were invalid; that they had only sold repair parts of the patented devices; that appellee had been guilty of misuse of its patents by its intentional delay in supplying repair parts to users of appellee's device; and that there was no properly admissible evidence to sus-

tain appellee's claim that appellants had been guilty of unfair competition.

The district court found that appellants were guilty of infringement, contributory infringement and unfair competition; and that appellee had not misused its patents as alleged.

On the argument of the case on appeal, in reply to interrogation by the court, it was conceded by appellants that the patents in suit were valid, so that issue may, at the outset, be eliminated from consideration.

[1] With the issue of validity of the patents removed from the case, appellants' contention that they were not guilty of contributory infringement appeared to be its strongest defense, but that defense fails in view of the finding of the district court, which was supported by evidence, that appellants had sold components of appellee's patented staplers; and under the new Patent Code of 1952, Title 35 U.S.C.A. § 1 *et seq.*, it is provided in Section 271(c):

> "Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer."

[2] It further appears that appellants sold magazine assemblies comprising all the elements existing in one of the claims of appellee's patents, which constitute infringement thereof under Title 35 U.S.C.A. § 271(a).

[3] The proofs further disclose that appellants had hired away from appellee an important employee who held the position of assistant to appellee's office manager.

in order to secure secret trade information consisting of a list of appellee's best accounts, and the prices charged to its customers, resulting in undercutting of prices by appellants and the loss of many customers and great damage to appellee. The evidence also shows that appellants used appellee's arbitrary name and number designations for parts and staples, which they affixed to parts and staples which were not manufactured by appellee, but which appellants sold to the customers of appellee without any other indication of their origin. The foregoing conduct, repeated on numerous occasions by appellants, amply supported the district court's findings that appellants were guilty of unfair competition. See *Goodyear Tire & Rubber Co.* v. *Marbon Corp.*, D. C., 30 F. Supp. 420; *Ford Motor Co.* v. *Alltite Motor Products Corp.*, D. C., 117 F. Supp. 460 and 117 F. Supp. 584; *Keller, Inc.* v. *Chicago Pneumatic Tool Co.*, 7 Cir., 298 F. 52.

[4] Appellants claim that the district court erred in its finding that one of appellee's patents was valid, after counsel for appellee had offered to withdraw it on the hearing. It appears that at the time the offer of withdrawal was made, appellee had failed to supply proof of infringement; but, thereafter, evidence which was introduced by appellants justified the court in retaining the patent in question for consideration on the question of validity of infringement; and, accordingly, no reversible error appears in this regard.

The findings of the district court are sustained by the evidence; and no error appearing in its conclusions of law, the judgment of the district court is affirmed.

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JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 522

SENCO PRODUCTS, INC.,

Petitioner,

vs.

FASTENER CORPORATION AND DUO-FAST CO.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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OPINIONS BELOW.

The opinions below, which are properly identified in the Petition (p. 2), establish that this is an ordinary patent infringement suit in which the two Lower Courts held invalid Petitioner's patent on a pneumatic hand operated stapling device. The concurrent holdings of invalidity over the prior art are plainly correct. Petitioner's attempt to obtain yet another review of this predominantly factual issue is transparently devoid of merit.

JURISDICTION.

Petitioner's statement of jurisdiction is correct insofar as it refers to 28 U. S. C. Section 1254, but there is no merit in Petitioner's attempt to obtain a review in this Court on the theory that a conflict of decisions of the Courts

of Appeals for the Sixth and Seventh Circuits concerning the validity of the patent in suit should be resolved (Petition, pp. 2, 8 and 9). Respondents submit that this "conflict" is spurious since validity was not contested in the Sixth Circuit. There is, consequently, no reason why the writ prayed for should be granted.

QUESTIONS PRESENTED.

The four abstract questions presented for review by Petitioner include unwarranted assumptions and qualifying fact elements not supported by the decisions below or by the record in this case. Answers to these questions, consequently, can have no bearing on the outcome of this suit.

STATEMENT OF THE CASE.

(a) The Sixth Circuit Litigation.

The Petition predicates jurisdiction upon an alleged conflict between the Courts of Appeals for the Sixth and Seventh Circuits about the validity of the patent in suit. Petitioner's statement concerning the Sixth Circuit case of *Sasser et al.* v. *Senco Products, Inc.*, 242 F. 2d 565 (C. A. 6, 1957) (Petition, App. B., p. 21), affirming, *Senco Products, Inc.* v. *Travis M. Sasser, et al.*, Civil Action No. 3638, Southern District of Ohio, Western Division (A. 501) needs elaboration. The most significant fact of that litigation is that the defendants never raised more than a formal objection to the validity of Patent No. 2,671,214.

The complaint in the Sixth Circuit litigation involved three patents, namely Patent No. 2,671,214 as to which Petitioner here seeks a review by this Court, Patent No. 2,687,522 which was held invalid by the District Court in the Seventh Circuit litigation and as to which Petitioner

took no appeal, and a Reissue Patent No. Re. 23,756 which was not involved in the Seventh Circuit litigation (A. 633-634, Paragraphs 6, 7 and 8). Aside from a general denial of the allegations contained in Paragraphs 6, 7 and 8 of the complaint, based upon a lack of "knowledge or information sufficient to form a belief" as to whether the patents were "duly and legally issued," the answer of defendant Sasser in the Sixth Circuit litigation dealt with the validity question only in Paragraph 28 thereof (A. 657) which rather equivocally reserved the right to plead further upon the defense of invalidity. No such further pleading was ever filed and no prior art was pleaded. When the defense attorney, at the end of the trial, introduced certain prior art references into evidence, he did so merely to show the state of the art (A. 665). Defendants failed to produce expert testimony explaining the state of the art to the Court or demonstrating how the prior art suggested Juilfs' alleged invention. Furthermore, defense counsel made clear that the prior art was of no importance by saying (A. 666):

> "I might say that practically this entire batch of patents are file wrapper references against these Juilfs patents. There are a few additional. They are not worth-while talking about."

It is also noteworthy that the prior art thus introduced in the *Sasser* litigation was quite incomplete. It did not include many of the items which Respondents in the present case put before the Lower Courts. A comparison of the prior art in the two cases shows (A. vi and 628) that Patents No. 451,995 to Bradeen; No. 798,416 to Jackson; No. 863,646 to Rice; No. 931,964 to Scott; No. 1,063,666 to Duryea *et al.*; No. 1,142,671 to Carmina; No. 2,187,692 to Oeckl; No. 2,241,184 to Clark; No. 2,304,650 to Pardee and No. 547,814 (Great Britain) to Hardypick, cited by Respondents and discussed by the Illinois District Court (A. 671) were not offered in the Ohio litigation. Also the

Randall commercial gun and the Fastener Duo-Fast compression tacker CT-800 mentioned by the District Court below (A. 675) were not before the Ohio Court.

In view of these circumstances the finding of validity of Juilfs Patent No. 2,671,214 in the *Sasser* case does not relate to a contested issue but is clearly akin to a consent judgment. *On appeal, validity was expressly conceded* (Petition, App. B., p. 22).

(b) The Seventh Circuit Litigation.

In the Illinois litigation Petitioner's suit against Respondents was based on only two of the patents involved in the Sixth Circuit litigation and differed vastly from the earlier litigation in that the defenses of prior invention and lack of invention were the central theme of the Illinois case. These questions were thoroughly explored and presented to the District Court by testimony in Court, depositions, numerous physical exhibits, explanatory charts and expert testimony. The briefs in the two Lower Courts as well as the published opinions of these Courts were principally concerned with the issue of validity.

The evidence of invalidity was convincing. The District Court held that both of the Juilfs patents were invalid for lack of invention, and although this was contrary to the uncontested holding in the Sixth Circuit, Petitioner did not appeal as to the later of the two patents, No. 2,687,522. The Seventh Circuit Court of Appeals not only held that the District Court's finding of invalidity as to Patent No. 2,671,214 was sustained by the evidence but added (Petition, App. A., pp. 19, 20):

> "The arrangement of the features incorporated by the plaintiff in its device did not possess the 'impalpable something which distinguishes invention from simple mechanical skill.' *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147. These

> features had been employed in other similar types of tools. Their adaptation by plaintiff resulted in an improvement but represents no more ingenuity than the work of a mechanic skilled in the art. There are no 'unusual or surprising consequences from the unification of the elements here concerned' nor did plaintiff's utilization of the features it mentions 'add to the sum of useful knowledge.' *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147."

The Illinois District Court and the Court of Appeals for the Seventh Circuit arrived at the conclusion of invalidity with full knowledge of the result of the *Sasser* case. Petitioner in the Courts below had unsuccessfully stressed the *Sasser* case as an important and persuasive precedent. The District Court answered these arguments correctly by saying (A. 672-673):

> "Senco cites a decision by the Sixth Circuit Court of Appeals, *Sasser et al. v. Senco Products, Inc.*, 242 F. 2d 565 upholding the validity and finding infringement of the patents here in suit. However, the validity of the patents in suit was conceded in that case and therefore, it offers nothing authoritative here. *Murray-Ohio Manufacturing Co. v. E. C. Brown Co.*, 124 F. 2d 426, 428."

The Court of Appeals thought so little of Petitioner's argument on this point that its opinion ignored it completely.

(c) The Nature of the Alleged Invention.

Novelty and patentability of Petitioner's pneumatic stapling tool are urged by Petitioner only as to two features, namely, the piston and driver are separate rather than connected and a separate stop is provided for the piston. It is asserted at pages 5 and 6 of the Petition that this arrangement results in accurately setting the staples without injuring the fabric and reduces driver

breakage. References to the record are absent from this part of the Petition. In fact, there is no supporting evidence in the record about these alleged problems and their solution by Juilfs other than self-serving statements in Juilfs' patents (column 1, lines 41-52; A. 687) and the parroting of these statements by Petitioner's expert (A. 12-16). Firsthand evidence of witnesses experienced in this art establishes that the alleged problems were not encountered in practice and that Juilfs' tool worked no better than pneumatic staplers in which the piston and driver were connected (A. 40-42, 47, 52-53, 82-83). Moreover, tools having only a single stop for the piston and driver, worked equally well (A. 60). The opinion of the Court of Appeals in this case refers to the proper staple setting and reduction of driver breakage not as actual but as "claimed" advantages of the Juilfs arrangement (Petition, App. A., p. 18). Since the patent was held invalid for lack of invention the opinion does not discuss the evidence refuting these claimed advantages.

ARGUMENT

1. There Is No Genuine Conflict Between the Two Courts of Appeals.

Petitioner invokes this Court's jurisdiction on the theory that the present case and the *Sasser* case have created a conflict of decisions which "must be resolved", and on the ground that "The industry is completely up in the air as to whether the patent is valid or invalid." (Petition, p. 9.) Respondents submit that the very opposite is true. If this case presents a conflict of decisions it is not a substantial but a purely formal conflict. The conflict is such that this Court should not resolve it. There is nothing in the record to show that the public or the staple industry, at this time, has any interest in the validity of the Juilfs patent.

Respondents agree that the Court of Appeals in *Sasser et al.* v. *Seneca* (Petition, App. B., p. 23) did not hold the Juilfs patent invalid. It may, however, be doubted whether its decision conflicts with that of the Court below. The articulate concurrent findings of invalidity in the present case were based on a great deal of evidence and argument of counsel. In contrast, the Court of Appeals for the Sixth Circuit at the outset "eliminated from consideration" the question of validity which had been conceded without argument by Appellants' counsel (Petition, App. B., p. 22). Thus, while the blanket affirmance of the judgment in the *Sasser* case may include the District Court's ruling on validity, the case essentially did not involve an appeal of the validity issue. Since the Court of Appeals in *Sasser* actually did not pass on the question of validity, its decision can hardly be said to conflict with that of the Court of Appeals in the present case.

If, however, the general affirmance of the District Court in *Sasser* were to be regarded as technically encompassing validity and conflicting with the Seventh Circuit's holding of invalidity such conflict would be attenuated to such a degree as not to merit solution by this Court. As previously indicated, Petitioner did not consider the "conflict" between the Sixth Circuit and the Illinois District Court of sufficient importance even to warrant an appeal as to Patent No. 2,687,522.

The unsubstantial nature of the conflict is further demonstrated by the way in which the validity issue was presented to and decided by the District Court in the *Sasser* case. The defendants in the Ohio litigation all but conceded validity in the District Court. The defendants' conduct in that case was epitomized in Seneco's brief as follows (A. 630):

> "Defendants did nothing before or at the trial to overcome Plaintiff's prima facie case of patent validity!"

In view of this fact the District Court's holding of validity followed almost as a matter of course from the statutory presumption of Title 35 U. S. C. Section 282 (Petition, p. 4). It was not a ruling on a contested issue.

Moreover, it does not appear that the Ohio Court even considered the defense of "lack of invention" which was sustained in this Seventh Circuit litigation. Instead, the Ohio Court merely held that the prior art patents introduced by defendants in that litigation "do not anticipate any of the claims" (A. 504, Finding 12). With this Respondents agree, but this finding is not in conflict with the Seventh Circuit.

From the above it is clear that any conflict which may exist between the Courts of Appeals for the Sixth and Seventh Circuits is not genuine. It is not the kind of con-

flict envisaged by Rule 19-1(b) of the Supreme Court Rules. That Rule, as stated in *Frankfurter and Hart, The Business of the Supreme Court at October Term, 1933, 48 Harvard Law Review* 238, 268 (1934), contemplates

> "The existence of a square conflict * * * the Court is interested in conflicts which impair uniformity of decision where uniformity is significant. * * *"

Respondents submit that no social interest would be served by resolving the "conflict" between the *Sasser* decision and the present litigation. The *Sasser* decision on its face, as well as upon its record, is most unlikely to be regarded as persuasive in any later case involving the issue of validity. Such cases will follow the Seventh Circuit decision insofar as they may be influenced by precedent. The fact that the Court of Appeals in this case did not even distinguish or comment on the *Sasser* case shows that it did not regard its decision as creating a genuine conflict with the Sixth Circuit. Other courts would unquestionably share this view if the validity of the Juilfs patent should become an issue in any future case.

Finally, it should be observed that Petitioner has not pointed to any instance in which this Court has taken jurisdiction to resolve the kind of conflict here presented. The fact is that certiorari has been denied in patent cases even though a genuine conflict existed. *S. H. Kress & Company v. Elie P. Aahnides, et al.*, 355 U. S. 889, 78 S. Ct. 261 (1957).

Furthermore, this Court has consistently refused to grant petitions for writs of certiorari in patent cases where the conflict was apparent only, rather than real. See *Westinghouse Electric Corporation v. Bulldog Electric Products Company*, Case No. 424, October Term 1953, Certiorari Denied 346 U. S. 909, 74 S. Ct. 240 (1953).

Nor has this Court hesitated to dismiss as improvidently

granted a writ of certiorari where, after full argument on the merits it appeared that there was no *real* conflict between Circuit Courts of Appeals as to the validity of a patent. In *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 393, 43 S. Ct. 422, 423 (1923), this Court in dismissing the writ said that certiorari should not be granted

> "* * * except in cases involving principles the settlement of which is of importance to the public, as distinguished from that of the parties; and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals."

Certainly there is no real and embarrassing conflict here, since the Sixth Circuit Court of Appeals did not consider or decide any contest as to whether the Juilfs patent was valid or invalid. The *Layne & Bowler* case was quoted from and cited with approval as recently as *Rice* v. *Sioux City Memorial Park Cemetery Inc., et al.*, 349 U. S. 70, 79, 75 S. Ct. 614, 619 (1955).

2. The Patent in Suit Is Invalid and Was Found to Be Invalid for Lack of Invention Regardless of How the Questions Presented in the Petition Should Be Answered.

The questions submitted by Petitioner are singularly unsuited for determination by this Court against the factual backdrop of the instant case. These questions are synthetic and unreal. As phrased by Petitioner they all include qualifying elements not present in this suit which make the answers to Petitioner's questions obvious as well as irrelevant. Thus, question No. 1 assumes that the District Court used an incorrect standard of invention; question No. 2 asks whether the Court of Appeals may act "arbitrarily"; question No. 3 assumes, contrary to the

facts, that Juilfs' patent achieved substantial commercial success; and question No. 4 assumes, contrary to uncontradicted expert testimony, that the Court of Appeals misunderstood the prior art.

Thus merely formal analysis of Petitioner's questions shows their lack of substantiality. A short analysis of the course of the litigation and the meaning of the decisions below will demonstrate further that the petition presents nothing deserving the attention of this Court.

The central problem before the Lower Courts was whether the slightly improved combination claimed by Juilfs contributed enough to the art to deserve patent protection. On this question both Courts examined the prior art introduced and explained by Defendants. Both Courts correctly understood the operation of the structure claimed by Juilfs. Both Courts concluded that Juilfs Patent No. 2,671,214 was invalid for lack of invention. The District Court expressed its holding as follows (A. 677-678):

> "When this operation is considered in light of the basic teachings of the Bradeen patent and of the whole field of staple driving and percussion type tools, the familiarity is apparent. The operation bears the unmistakable stamp of improvement and development **which is the result of mechanical skill only.** Nowhere in the operation can I find the flash of creative genius which is necessary to constitute invention. *Cuno Engineering Corporation* v. *Automatic Devices Corporation*, 314 U. S. 84. The utility and commercial success of the '214 patent cannot create patentability where invention is lacking. *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corporation*, 340 U. S. 147. Therefore, I hold the '214 patent invalid for lack of invention." (Emphasis added.)

The citation of the *Cuno* case and the use of the words "flash of creative genius" were seized upon by Petitioner to urge to the Court of Appeals that the District Court's

finding of invalidity resulted from the application of an incorrect standard of invention. Clearly the passage quoted does not support this charge. It is equally clear that the Court of Appeals was not bound to discuss each argument advanced by Appellant and committed no error in refusing to comment on Appellant's disingenuous contention about the standard of invention. The Court of Appeals agreed with the holding that the Juilfs patent was uninventive over the prior art and Petitioner has no quarrel with the standard of invention applied by the Court of Appeals. Consequently, the affirming opinion's silence about the standard of invention can not have been prejudicial to Petitioner's case and should not be reviewed on certiorari.

The concurrent findings of invalidity are clearly correct in view of the prior art. Petitioner's assertion that the prior art was misunderstood involves a question of fact not suited for review by this Court. Moreover, the opinion of the Court of Appeals affirmatively shows that it made no mistake about the three prior art items to which Petitioner directs the attention of this Court.

With respect to the Randall commercial gun the Court of Appeals said (Petition, App. A, p. 19):

> "* * * there was a loose connection between the piston and driver * * *"

This is in accord with the uncontradicted testimony of Defendants' expert (A. 68). About the same item Petitioner says that (Petition, p. 12):

> "* * * the connection between the driver and the piston is characterized by a few thousandths of an inch of play. * * *"

In substance these two statements agree.

Discussing Von Vass Patent No. 1,186,458 (A. 801-805) the Court below stated (Petition, App. A, p. 19):

> "The Von Vass patent 1,186,458 covering a nailing device employed a piston which was separate from the driver. The piston was stopped independently of the driver. A spring served as a stop for the driver."

This is accurate, and again is in strict accord with the uncontradicted testimony of Defendants' expert (A. 63). Petitioner's suggestion that the contrary can be shown by "measuring" the figures of the patent drawings was rejected *sub silentio* by the Court of Appeals.

Finally, with respect to Carmina Patent No. 1,142,671 (A. 792-800) the Court of Appeals correctly said (Petition, App. A, p. 19):

> "The Carmina patent 1,142,671 disclosed a construction in which a recessed piston is arranged to receive and drive a separate driver, provisions being made for separate stops, for the piston and driver."

Defendants' expert witness described the Carmina structure in detail (A. 71) and the Court's understanding, as expressed above, is strictly in accordance with his explanation. Contrary arguments of Petitioner's counsel, without supporting testimony, cannot establish any mistake by the Court of Appeals. It is thus clear that the prior art was correctly analyzed by the Court of Appeals and that it fully supports the holding of invalidity.

Petitioner further contends (Petition, p. 10) that the opinion below is erroneous because of the following statement (Petition, App. A, p. 20):

> "The presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office. *Hobbs* v. *Wisconsin Power & Light Company*, 250 F. 2d 100, 105. Of the aforesaid prior art relied upon by the defendants only Randall and Pardee patent 2,304,650 were before the Patent Office."

The rule enunciated in the above passage is universally

recognized.* The failure of the Patent Office to cite *pertinent* references against an application greatly impairs the presumption of validity of the patent issuing upon such an application. *Adler Sign Letter Co., et al.* v. *Wagner Sign Service, Inc.*, 112 F. 2d 264, 267 (C. C. A. 7, 1940) does not conflict with the above rule, but merely limits it to the Patent Office's failure to cite *pertinent* prior art. Since the references on which the Courts below invalidated the Juilfs patent were highly pertinent, it cannot reasonably be presumed that the Patent Office was aware of them but did not consider them worth citing. The following passage from *Nordell, et al.* v. *International Filter Co.*, 119 F. 2d 948, 950 (C. C. A. 7, 1941) convincingly states the reasons for the rule:

> "There was considerable prior art not cited by the Examiner, **which we think is quite pertinent.** Among this prior art were certain German publications which clearly described the comminution of solids in liquids without removing the solids from the stream. * * * **This accomplishment was precisely what Nordell told the Examiner was new in the art,** and there can be no presumption of validity over this prior art which the Examiner did not note. We are here confronted with a **strange doctrine,** that the fact that the Examiner did not mention this art raised no presumption that he did not see it and consider it. But on the other hand, appellees urge that it raises a presumption that the Examiner was aware of it and did not consider it applicable. **We do not understand this to be the law.**" (Emphasis added.)

* *H. Schindler & Co., Inc.* v. *C. Saladino & Sons, Inc.*, 81 F. 2d 649, 651 (C. C. A. 1, 1936); *Zoomar, Inc.* v. *Paillard Products, Inc.*, 258 F. 2d 527, 530 (C. A. 2, 1958); *Dole Refrigerating Company* v. *Amerio Contact Plate Freezers Inc.*, 265 F. 2d 627, 629 (C. A. 3, 1959); *Gillette Safety Razor Co.* v. *Cliff Weil Cigar Co. Inc.*, 107 F. 2d 105, 107 (C. C. A. 4, 1939); *Cornell et al.* v. *Adams Engineering Company, Inc.*, 258 F. 2d 874, 875 (C. A. 5, 1958); *Royal Patent Corp. et al.* v. *Monarch Tool & Mfg. Co.*, 203 F. 2d 299, 300 (C. A. 6, 1953); *Hobbs* v. *Wisconsin Power & Light Company*, 250 F. 2d 100, 105 (C. A. 7, 1957); *Rohr Aircraft Corporation et al.* v. *Rubber Teck, Inc. et al.*, 266 F. 2d 613, 617-618 (C. A. 9, 1959).

The Court of Appeals concluded its opinion saying (Petition, App. A, p. 20):

> "We hold the patent invalid for lack of invention. Consideration of commercial success is therefore irrelevant. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147."

Petitioner's contention that this was prejudicial error is untenable for two reasons.

It is well established that commercial success becomes relevant only if the question of validity is in doubt. The cases cited by Petitioner (Petition, p. 11) so hold. Since both Lower Courts were firmly convinced that the Juilfs patent was the result of mere mechanical skill, the alleged commercial success could not lead to a reversal of the District Court. The second reason why commercial success could not influence the ruling on validity is the lack of substantial evidence on this point.

Conclusion.

For the foregoing reasons it is respectfully submitted that the Petition should be denied.

Respectfully submitted,

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PETITIONER'S REPLY BRIEF.

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PETITIONER'S REPLY BRIEF.

Respondents in their brief appear to rely primarily on the position that the conflict between the Sixth and Seventh Circuit decisions is apparent rather than real. This argument is based on the reasoning that counsel in the Seventh Circuit argued the question of validity strenuously while counsel in the Sixth Circuit raised the question of validity with less vigor. Regardless of the accuracy of this premise, the fact of whether or not a conflict exists depends not on what was **argued** in the two circuits but, rather, on what was **decided** by the courts involved. The Sixth Circuit Court of Appeals found the Juilfs patent 2,671,214 to be valid. The Seventh Circuit found the patent to be invalid. To argue that the courts reached their decisions on the basis of different arguments cannot in any way erase the basic conflict that exists between the decisions in the two circuits.

To sustain their position that no conflict exists unless

the issues were presented in a similar manner. Respondents cite three cases (Respondents' Brief, pp. 9-10). These cases completely fail to support Respondents' position. Respondents cite *S. H. Kress & Company* v. *Elie P. Aghnides, et al.*, 355 U. S. 889, 78 S. Ct. 261 (1957), and *Westinghouse Electric Corporation* v. *Bulldog Electric Products Company*, Case No. 424, October Term 1953, Certiorari Denied 346 U. S. 909, 74 S. Ct. 240 (1953), as supporting their position but both of these cases are merely memorandum decisions where certiorari was denied and no reason for the denial is stated. The third case, *Layne & Bowler Corporation* v. *Western Well Works, Inc.; et al.*, 261 U. S. 387, 393, 43 S. Ct. 422, 423 (1923), is a patent case where the two circuits found the patent valid, found certain claims infringed, and interpreted the claims similarly. This Court found that no conflict existed, as it obviously did not.

What was **decided** in the Sixth Circuit is as follows:

In its appeal in the Sixth Circuit case, the defendant set forth as its item 19:

> "19. Does the state of the patented art, exemplified in defendant's exhibit 18, establish that the patents in suit are invalid and void for want of invention?
>
> The Trial Court answered 'No'.
> The answer should be 'Yes'."

This item 19 was paraphrased as question number 4 in Appellee's (Petitioner here) brief to the Court of Appeals for the Sixth Circuit (A. p. 629). The patents in the exhibit 18 referred to are listed in full (A. pp. 628-629). These **39** patents include both Von Vass 1,186,458 and Randall 1,939,632 which are so much relied upon by Respondents.

The District Court (in the Sixth Circuit) made the following finding of fact as to the patent here in suit (A. pp. 503-504):

"9. The claims of Patent No. 2,671,214 are directed to a novel, pneumatic tool for driving staples in production line work and in particular these claims are directed to what has become known as the 'free running driver' feature of construction; a tool incorporating this feature includes a piston having a recess, a driver free of the piston but having means to seat within the recess, a spring resisting movement of the driver, a separate stop for the piston, a main casting in which the parts are housed, and pneumatic means including a firing valve whereby the piston is moved against the driver and its spring so that the driver will contact a staple and move it into the work. If fired in the open, the driver is free to advance by its momentum, even after the piston has stopped, and this is what is termed the free running driver. The claims are also directed to the described basic elements in combination with novel nose structure for properly guiding the staple as driven. The claims of this patent define a structure which has proved to be a meritorious contribution to the art and of use and advantage to the public."

The Court of Appeals, Sixth Circuit, 242 Fed. (2d) 565, concluded its opinion with the following Finding and Judgment (App. B., p. 23):

"The findings of the district court are sustained by the evidence; and no error appearing in its conclusions of law, the judgment of the district court is affirmed."

The District Court (in the Sixth Circuit), which was affirmed in its Judgment, had also held (A. p. 508):

"Plaintiff has sustained the burden of proof of its Complaint and is entitled to judgment in accordance with the prayer thereto as follows:

1. It is decreed that Plaintiff's aforesaid letters patent No. 2,671,214 are good and valid and have been infringed by Defendants Travis M. Sasser (an individual also doing business as Cincinnati Shippers Supply * * *)."

There is a well known principle that courts speak by Judgments. The Judgment of the Court of Appeals of the Sixth Circuit was as follows:

> "THIS CAUSE came on to be heard on the transcript of the record from the United States District Court for the Southern District of Ohio, and was argued by counsel.
>
> ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.
>
> Approved for entry:
>
> /s/ THOMAS F. MCALLISTER,
> *United States Circuit Judge.*"

Under the present state of affairs the general public is faced with a situation where the patent is valid in the Sixth Circuit and invalid in the Seventh, but the public has no idea of the status of the patent in other jurisdictions. The general public is a party in interest in this case and the writ should therefore issue.

Respectfully submitted,

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